

REMARKS

By the foregoing amendments, claims 3 and 48 have been amended to recite that the coated substrate is cured or allowed to dry after being contacted with the recording liquid. Support for this language may be found in applicant's specification; for example, in the Examples beginning at page 23, wherein the coated substrate (*i.e.*, a coated or printed sheet) is allowed to dry after ink is printed on the sheet. With regard to curing of the coated substrate, it is noted that the addition of crosslinking agents (*i.e.*, compounds that may provide a cured coating) is discussed in the specification, *e.g.*, at page 17.

Entry of the foregoing amendments is kindly requested in the interest of expediting the prosecution and removing the remaining issues from consideration. In this regard, it is respectfully submitted that the present amendments to the claims do not raise any additional issues requiring further consideration and/or search by the Examiner. As the Examiner will note, the amendments simply remove issues from consideration and do not add any additional features not previously claimed. As the subject matter of the present claims was previously under consideration by the Examiner, entry of the foregoing amendments is proper.

Following entry of the above amendments, the status of the claims is as follows (as indicated in the listing of claims set forth above):

Claims 5, 8-11, 15-20, 41-46, and 56-62 stand canceled without prejudice or disclaimer;
Claims 3 and 48 have been currently amended;
Claim 63 stands withdrawn as being directed to non-elected species; and,
Claims 1-4, 6, 7, 12-14, 21-40, 47-55, 63 and 64 remain pending.

Non-elected Species Claim 63:

In the Official Action (page 2 of the Detailed Office Action), the Examiner has indicated that claim 63 has been withdrawn from further consideration based upon a species election requirement and applicant's election of polyethyleneimine as species for the polymeric polybase (see applicant's response filed July 12, 2002 to the Restriction and Species Election Requirement dated June 12, 2002).

As noted in applicant's remarks of the July 12, 2002 response, however, the Restriction and Species Election Requirement dated June 12, 2002 did not include a requirement that a species for the polymeric polybase be elected. Although applicant did state that polyethyleneimine was to be elected as the polymeric polybase "in the event the Examiner should deem such an election necessary" (see page 2 of the July 12, 2002 response), to date, there has been no statement on the record to clearly indicate that a species election was required by the Examiner for the polymeric polybase. In order that

the record may be properly clarified, applicant kindly requests the issuance of a statement in the next Official Action that such a species election has been required by the Examiner.

Applicant further notes that the Office Action Summary page of the Official Action lists claim 63 as being rejected, while the text of the Detailed Action states (at page 2) that claim 63 has been withdrawn from consideration as being drawn to non-elected species. Claim 63 is also not included in any of the rejection or objection statements of the Detailed Action. It is therefore presumed that the inclusion of claim 63 as a rejected claim on the Office Action Summary page is in error. Should this understanding not be correct, the Examiner is kindly requested to provide a clarification of the status of claim 63 in the next Official Action.

Rejections Under 35 U.S.C. §112, First Paragraph:

Claims 1-4, 6, 7, 12-14, 21-40, 47-55 and 64 stand rejected as allegedly failing to comply with the written description requirement. Applicant respectfully traverses this rejection for at least the following reasons.

In the outstanding Official Action, separate issues have been noted by the Examiner based upon the previous amendments to claims 1 and 47; claims 3 and 48; claim 28 and claim 29. Each of these issues will be discussed, in turn, below.

Claims 1 and 47 have been noted as reciting that combinations of surfaces for the substrate surface may be utilized. It is asserted in the Official Action, however, that such combinations are not described in the specification since no "literal support" for such combinations is allegedly evident. Applicant respectfully traverses this rejection for at least the following reasons.

At the outset, applicant notes that it is generally not required for the subject matter of the claims to be described in the specification with exactly the same language, or in the same manner, as is utilized in the claims. Instead, it is only necessary that a sufficient description be provided in the specification to show one skilled in the relevant art that applicant possessed the claimed invention at the time of filing. See, e.g., *Union Vil. Co. of Calif. v. Atlantic Richfield Co.*, 208 F.3d 989, (CAFC 2000), 54 PQ2d 1227, citing *Vas-Cath, Inc., v. Mahurkar*, 935 F.2d 1555 (CAFC 1991), 19 PQ2d 1111. As is further stated in the MPEP at section 2163 IIA(3)(b), each claim limitation of an amended claim "must be expressly, implicitly, or inherently supported in the originally filed disclosure."

With the above in mind, applicant respectfully notes that it is not necessary for the specification to describe the claimed combinations of substrate surfaces using the literal language provided in the

claims themselves. Other descriptive information may be provided in the specification in order for the skilled artisan to have recognized that applicant was in possession of the claimed invention.

In this regard, applicant submits that one skilled in the art would understand that the originally filed disclosure provides support for the claimed combinations of substrates. For instance, as noted by applicant at page 5, lines 4-5, of the specification, the singular forms of "a," "an," and "the" include the plural referents. The same understanding, then, implicitly applies to the singular form of "a substrate" having "a surface" selected from "the" surfaces recited in each of claims 1 and 47 such that the plural forms of such substrates and surfaces are included. Combinations (*i.e.*, "mixtures") of such referents, in this case the substrate surfaces, are also discussed as being included within this language by applicant at this section of the specification. The skilled artisan would therefore recognize such information as indicating that applicant was in possession of the claimed subject matter, *i.e.*, combinations of surfaces on the substrate or substrates.

For at least the foregoing reasons, applicant submits that the specification does provide, for the skilled artisan, an adequate description of the claimed combinations of surfaces. Applicant respectfully requests that the Examiner reconsider this issue and withdraw the first paragraph rejection of claims 1 and 47.

Claims 3 and 48 have also been noted in the Official Action as reciting that the opaque coating composition on the substrate is cured or allowed to dry after being contacted with the recording liquid." It is asserted in the Official Action, however, that drying the opaque coating composition after application of the recording liquid is not described in the specification since no "literal support" is allegedly evident for drying of the opaque coating composition *after* application of the recording liquid. Applicant respectfully traverses this rejection for at least the following reasons.

As noted above, "literal support" for the language of the claims is not necessary for the written description requirement to be satisfied. Instead, based upon applicant's disclosure, the skilled artisan need only recognize that applicant was in possession of the claimed subject matter.

In the present case, one skilled in the art would easily appreciate that only two possibilities exist concerning the condition of the opaque coating composition as it is contacted with the recording liquid, namely: the opaque coating composition is either dry before it is contacted with the recording liquid, or it is not dry when contacted with the recording liquid. According to the latter condition, the printed coating may, of course, be dried after being contacted with the recording liquid. Both conditions would furthermore be recognized by the skilled artisan as being part of applicant's disclosure at least for the reason that neither condition is specifically excluded. The skilled artisan would therefore implicitly

understand that applicant included both conditions of the opaque coating composition as it is contacted with the recording liquid within the application disclosure.

Applicant further notes that the disclosure in the Examples of drying of the coating composition before the coating is contacted with the recording liquid, as mentioned by the Examiner in the Official Action, in no way limits the scope of applicant's claims to only the details provided in these Examples. In other words, applicant's claims are not to be limited according to any examples applicant may choose to provide for the purposes of illustration. As the Examiner will no doubt appreciate, applicant is entitled to claim his invention according to the disclosure provided by the specification, as understood by the skilled artisan, and not simply based upon any examples included with the application.

For at least the foregoing reasons, applicant submits that the specification does provide, for the skilled artisan, an adequate description of curing or drying of the opaque coating composition on the substrate after being contacted with the recording liquid. Applicant respectfully requests that the Examiner reconsider this issue and withdraw the first paragraph rejection of claims 3 and 48.

Notwithstanding the above discussion, and solely in the interest of expediting the prosecution, each of claims 3 and 48 has been amended to recite that the coated substrate is cured or allowed to dry after being contacted with the recording liquid. As noted previously, this language is clearly supported in the Examples beginning at page 23 and at page 17 of the specification. The amendments to these claims are meant to simplify the Examiner's further consideration of the claims language and are not to be interpreted as an acquiescence or surrender of any subject matter covered by the claims. More specifically, applicant respectfully notes that the claims provide coverage for any condition of the opaque coating composition at the time it is contacted with the recording liquid.

Claim 28 has also been rejected since the specification allegedly fails to literally support the opaque coating composition as being an image-enhancing composition. Applicant respectfully traverses this rejection for at least the following reasons.

As originally filed, claim 28 referred to "the image enhancing composition," and depended from independent claim 1. The only "composition" mentioned in independent claim 1 (as well as in dependent claim 22, from which claim 28 now depends) is the "opaque coating composition." As such, the skilled artisan would recognize that applicant has described the opaque coating composition as an "image enhancing composition." In addition, since the claims are part of the specification, one skilled in the art would understand that applicant has provided an adequate description of the claimed subject matter at the time the application was filed.

For at least the foregoing reasons, applicant submits that the specification does provide an adequate description of the opaque coating composition as being an "image enhancing composition."

The Examiner is kindly requested to reconsider this issue and withdraw the first paragraph rejection of claim 28.

Claim 29 has been further rejected since the specification allegedly fails to explicitly mention the claimed ranges for the film-forming binder. Applicant respectfully traverses this rejection for at least the following reasons.

As originally filed, claim 29 recited a content range of "approximately 1 wt.% to approximately 50 wt.%" for the film-forming binder, whereas claim 28 recited a content range of "approximately 1 wt.% to approximately 40 wt.%" for the film-forming binder." The content range presently claimed in claim 29 is therefore explicitly supported by original claim 28. (As the Examiner will note from applicant's prior amendments, claims 28 and 29 were amended so that claim 29 further limited claim 28, essentially by switching the originally claimed content ranges.) As with the discussion concerning claim 28 above, since the claims are part of the specification, applicant has provided an explicit description of the claimed subject matter (*i.e.*, the claimed range of approximately 1 wt.% to approximately 40 wt.%) for one skilled in the art based upon the originally filed disclosure.

For at least the foregoing reasons, applicant submits that the specification does properly describe the claimed subject matter. The Examiner is kindly requested to reconsider this issue and withdraw the first paragraph rejection of claim 29.

Objections Under 37 C.F.R. §1.75(c):

Claim 12 stands objected to as allegedly failing to further limit the subject matter of a previous claim. Applicant respectfully traverses this objection for at least the following reasons.

In the outstanding Official Action, it is asserted that claim 12 fails to further limit claim 3 since "[b]oth claims recite that the opaque coating is dried." Applicant respectfully disagrees.

Claim 3 actually recites that the "substrate is cured or allowed to dry after being contacted with the recording liquid," whereas claim 12 recites that the "opaque coating on the substrate is allowed to dry." Claim 12 therefore further limits claim 3 since, of the two alternatives mentioned in claim 3 (*i.e.*, "cured or allowed to dry"), claim 12 recites only the latter (*i.e.*, drying of the coating).

For at least the foregoing reasons, applicant respectfully submits that the objection to claim 12 as failing to further limit claim 3 is improper. Withdrawal of the objection to claim 12 is requested.

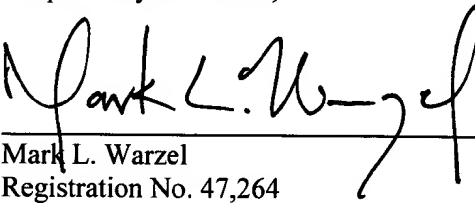
SUMMARY

The above arguments and amendments are submitted for the purpose of facilitating allowance of the claims and in a effort to place the application in condition for allowance. An early notice of allowance is earnestly solicited.

If there are any questions concerning the foregoing amendments or remarks, or if a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned at (650) 330-0900.

Respectfully submitted,

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